

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

In the specification, the paragraphs [0040] and [0041] have been amended to correct minor editorial problems, and to overcome various objections and rejections. No new matter has been added as a result of these amendments.

Claims 1-32 remain in this application. Claims 33-38 add one or more additional features from the specification.

The examiner objects to figure 4A because element 47 is not described in the specification. The specification has been amended to include element 47, and thus the objection is moot.

Claims 6, 20, and 21 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. Claim 6, 20, and 21 have been amended, making the rejection moot.

With regard to the biasing of the springs 42, applicant disputes that the manner of the biasing is not adequately disclosed. One skilled in the art would understand how to practice such a feature given the drawings Figs. 4A and 4B and the accompanying description. Accordingly, applicant does not understand the Examiner's position on this issue, and requests further clarification.

Claims 10-14 and 22-26 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. For the following reasons, the rejection is respectfully traversed.

Regarding the term "joint assembly" applicant notes that the term is used in paragraph [0029] as filed, referring to item 7A in the figures. Furthermore, paragraphs [0040] and [0041] have been amended to include the term. Finally, the term is used in various paragraphs in the Summary of the Invention. The use of the

term in the specification, along with the drawings, is sufficient to allow one skilled in the art to practice that feature.

As to the other rejections, amendments to the claims make the rejections moot. Accordingly, the rejections should be withdrawn.

Claims 5 and 7-9 were rejected under 35 U.S.C. §102(b) as being anticipated by Hsu (U.S. 4,951,730). For the following reasons, the rejection is respectfully traversed.

Claim 5, as amended, recites a canopy which can be deployed or retracted, "outward or inward, from or to the wall, respectively". Hsu does not disclose any such canopy. Accordingly, claim 5 is patentable over the reference. Claims 7-9, which depend on claim 5, are thus patentable over the reference for at least the same reasons as claim 5.

Claims 1-4 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hsu in view of Yamaguchi et al. (U.S. 5,799,716). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a "support arm for supporting said canopy outward from the wall when deployed". Neither Hsu nor Yamaguchi suggest such a canopy or support arm. Thus, claim 1 is patentable over the references.

Claims 2-4, which depend on claim 1, are thus patentable over the references for at least the same reasons as claim 1.

Regarding claim 6, which depends on claim 5, Yamaguchi fails to overcome the shortcomings of Hsu with regard to claim 5, and thus claim 6 is patentable over the references for at least the same reasons.

Claims 10-19, 22-26, and 30-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Girard (6,782,936) in view of Hsu. Claims 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Akers (3,847,171) in view of Hsu. For the following reasons, the rejections are respectfully traversed.

The Examiner cites Girard or Akers, references directed toward an awning

system for a vehicle, for providing shelter from weather elements (e.g., sun or rain), in combination with a non-analogous reference, Hsu, directed toward a motorized window blind system for blocking a view from a window. Such a combination is not proper. The similarities and differences in structure and function of the inventions carry great weight in determining if art is analogous. See MPEP §2141.01(a). See *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). The functions of the devices are quite different. Window blinds are intended to block a view from a window, and totally block incoming light. In contrast, the function of the invention and Girard, as teaching window awnings, is a different field of endeavor, one of providing a *shelter* from the weather outdoors. Accordingly, the Hsu reference is not reasonably pertinent to the problem with which the inventor or Akers or Girard is concerned because a person having ordinary skill in the art of outdoor window awning design would not reasonably have expected to solve that problem by considering a reference dealing with window blinds. See *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

Further, the structures are quite different. Window blinds as taught by Hsu are used indoors and required to travel in solely a vertical direction, whereas an awning travels at least partially in a horizontal direction. Accordingly, Hsu is not directed toward an analogous endeavor, the combination of references is not proper.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner merely states that it would have been obvious to modify Girard/Akers to add the solar device of Hsu so as to render the awning independent of a power supply from a house or vehicle. But this is nothing more than a benefit of

the Hsu reference. Where does Girard or Akers state the desirability of such a benefit? What would lead one skilled in the art, reading Girard or Akers and faced with the problems disclosed in Girard or Akers, to the Hsu solutions? Similarly, what would lead one reading Hsu, faced with the problems disclosed in that reference, to the Girard or Akers features? Surely, the Examiner cannot merely recite a benefit of Hsu, and then merely rely on that benefit for motivation. Such an approach would mean that Hsu (and any other reference, for that matter), is self-motivating, making the legal requirement for motivation meaningless. Clearly, that is not the law, and something more is required.

In examining the caselaw, and the MPEP, is clear that merely listing an advantage or benefit of the combination is *not* sufficient, as some specific rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art, that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn. Consequently, claims 10-19, 20-26, and 30-32 are patentable over the references.

Claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Knight *et al.* (3,722,571) in view of Girard. Claims 27 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heiser (1,856,161) in

view of Girard. For the following reasons, the rejection is respectfully traversed. For the following reasons, the rejection is respectfully traversed.

The Examiner has again failed to make a prima facie case of obviousness, because the stated motivation for combining the references is not sufficient. Merely stating the benefit of Girard (i.e., that it would be obvious to add the features of Girard so as to "automate the awning operation" of Knight or Heiser) is not legally sufficient motivation. There are many ways to achieve automation. Why would one skilled in the art choose the Girard solution? The Examiner provides us no answer to that question. Accordingly, claims 27, 28, and 29 are patentable over the references.

Finally, new claims 33-38 recite additional features not found in the references, and thus are patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34980.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

March 9, 2005